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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,033	08/22/2001	Ieyasu Kobayashi		8235

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EXAMINER

RIVERA, WILLIAM ARAUZ

ART UNIT PAPER NUMBER

3654

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/914,033

Applicant(s)

KOBAYASHI ET AL.

Examiner

William A Rivera

Art Unit

3654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasaki et al (U.S. Patent No. 4,576,344).

With respect to Claims 1-3 and 16-18, note that Sasaki et al teach a polyester film roll free from wrinkles. Therefore, the difference R between the minimum diameter value is not more than  $2W \times 10^{-3}$  because the width of the roll is uniform throughout the roll and such is the case for the condition  $L \times 10^{-7}$

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-15 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki et al as applied to claims 1-2 and 16-17 above.

Sasaki et al do not mention the specific dimensions in term of rolling hardness or flexural modulus etc. However, it would have been an obvious matter of design choice, as determined through routine experimentation and optimization, to dimension the polyester film roll of Sasaki

Art Unit: 3654

et al as specified in Claims 4-15 and 19-24 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

### *Response to Arguments*

With respect to applicant's remarks on pages 8-9, it is the applicant's position that the examiner's arguments are flawed because the invention focuses on the difference between maximum and minimum diameter values.

In the instant case, it should be noted that Sasaki et al does teach maximum and minimum diameters because all circular articles have diameters. The only difference is that in the Sasaki et al reference the maximum and minimum diameters equal zero. Therefore, the minimum diameter is not more  $2W \times 10^{-3}$  and not more than  $L \times 10^{-7}$ .

With respect to applicants' remarks on the last paragraph of page 9 and relying upon inherency it is the applicants' position that the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art.

The Sasaki et al reference clearly teaches a polyester roll free from wrinkles and discusses the merits of such rolls. See, for example, Column 5, lines 17-27. It is well known in the art, and intuitively apparent, that a wrinkle free roll would have a uniform diameter along its width. Thus, the claim limitation defining a maximum ("not more than") difference between the maximum and minimum diameters is met because zero is less than the defined maximum. Therefore, the examiner has provided a basis in fact and a line of technical reasoning which show that the minimum diameter is not more  $2W \times 10^{-3}$  and not more than  $L \times 10^{-7}$ . Further, if

Art Unit: 3654

it is still the applicant's position that Sasaki does not meet the limitation, then applicant must provide factual evidence, such as test results, as to why Sasaki does not meet the claim. Mere allegations that the claim is not met are insufficient absent such factual evidence.

With respect to the limitation "*wherein the first maximum perpendicular line length is not more than 300 micro-meters*", it should be noted that it appears that applicant's are claiming the graph shown in Figure 6. This is considered to be a product-by-process claim. In this type of claims, determination of patentability is based on the product itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Therefore, applicants are merely claiming a polyester film roll having a plurality of diameters.

With respect to applicant's remarks at the bottom of page 10 and the Sasaki et al reference, it should be noted that Sasaki et al do approach the problem in a different way, i.e., controlling the roll hardness while the instant invention measures the variations in the roll diameter. While the Sasaki et al and instant invention use different approaches, the end result (a wrinkle-free roll) is the same. Therefore the diameter limitation would also be met based on the inherency reasoning advanced above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3654

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William A Rivera whose telephone number is 703-308-2684. The examiner can normally be reached on Monday to Friday - 7:30 to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on 703-308-2688. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**WILLIAM A. RIVERA**  
**PRIMARY EXAMINER**

July 29, 2004